

**REMARKS**

Reconsideration and allowance of the subject application are respectfully requested. Claims 1-21 are now pending, claims 1, 3, 5, 7, 12, and 17 being independent.

**Prior Art Rejection**

Claims 1-6 stand rejected under 35 U.S.C. § 103 as allegedly being unpatentable over *Yoshimura* (U.S. Patent 6,463,172) in view of *Masayuki* (JP 8-221546). This rejection, insofar as it pertains to the presently-pending claims, is respectfully traversed.

Independent claim 1 is directed to an image processing method, which comprises the steps of: receiving selection of a target image having a desired color-tone from a plurality of reference images, each including the same image, each having a different color-tone; receiving specification of an area in an image displayed; and changing a color-tone of a desired area including the specified area to the color-tone of the target image.

Therefore, as amended, claim 1 specifies that the target image having a desired color-tone is selected from a plurality of reference images that each include the same image, each having a different color-tone.

The primary reference, *Yoshimura*, discloses an image processing method and apparatus, which perform color-tone conversion on a target image based on a reference image. Col. 2, line 62 - col. 3, line 26. As evident for example from the

Background section, this conversion is performed so that the reference image and the target image may be combined ("synthesized") while ensuring consistent color-tone in the combined image.

Although *Yoshimura* performs color-tone conversion based on a reference image, *Yoshimura* fails to teach or suggest that the selection is made from among a plurality of reference images, each including the same image, each having a different color-tone, as now clearly recited in independent claim 1. Furthermore, the Examiner's reliance on the secondary reference, *Masayuki*, fails to make up for this deficiency.

To establish *prima facie* obviousness, all claim limitations must be taught or suggested by the prior art and the asserted modification or combination of prior art must be supported by some teaching, suggestion, or motivation in the applied reference or in knowledge generally available to one skilled in the art. *In re Fine*, 837, F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). Thus, "[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). The prior art must suggest the desirability of the modification in order to establish a *prima facie* case of obviousness. *In re Brouwer*, 77 F.3d 422, 425, 37 USPQ2d 1663, 1666 (Fed. Cir. 1995). It can also be said that the

prior art must collectively suggest or point to the claimed invention to support a finding of obviousness. *In re Hedges*, 783 F.2d 1038, 1041, 228 USPQ 685, 687 (Fed. Cir. 1986); *In re Ehrreich*, 590 F.2d 902, 908-09, 200 USPQ 504, 510 (CCPA 1979).

In view of the above, Applicant respectfully submits that the asserted combination of *Yoshimura* and *Masayuki* (assuming these references may be combined, which Applicant does not admit) fails to establish *prima facie* obviousness of claim 1, or any claim depending therefrom.

Furthermore, Applicant submits that independent claims 3, 5, 7, 12, and 17, and their respective dependent claims, define over the asserted combination at least based on similar reasoning to that set forth above.

With specific reference to dependent claim 2, the Examiner asserts on page 3 of the Office Action that *Yoshimura* discloses generating a plurality of reference images before receiving the selection of a target image, citing col. 6, lines 53-69. Applicant submits, however, that this cited section of *Yoshimura* discloses that an image after color-tone conversion is combined with another image (an image specified by a user re "reference image") to produce a synthesized image. Therefore, *Yoshimura* fails to teach or suggest the function of generating a plurality of reference images in advance in the manner recited in dependent claim 2.

At least in view of the above, Applicant respectfully requests reconsideration and withdrawal of the Examiner's rejection under 35 U.S.C. § 103 based on the asserted combination of *Yoshimura* and *Masayuki*.

**Conclusion**

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact the undersigned at the telephone number below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

Applicant respectfully petitions for a one (1) month extension of time pursuant to 37 C.F.R. §§ 1.17 and 1.136(a). A check in the amount of \$110.00 in payment of the extension of time fee is attached.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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